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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/354,450	12/12/1994	GARY K. MICHELSON	P10936V	3041

22882 7590 12/01/2005

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EXAMINER	
DEMILLE, DANTON D	
ART UNIT	PAPER NUMBER
3764	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 11/26/05

Application Number: 08/354,450
Filing Date: 12 December 1994
Appellant(s): Gary Karlin Michelson, M.D.

Todd Martin
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the reply brief filed 01 September 2005.

Appellant argues under the "New matter objection and lack of support rejections" A3 that there is no basis to support the objection and rejection of the method claims 273-292 that method claims do not require the same structural detail as apparatus claims. The examiner respectfully disagrees. It is believed that the new language to the claims including the method claims raises questions if the claims are supported by the original disclosure. Method claim 293 for example, refers to the disclosed disc/head 18, 118 as a "member being at an acute angle relative to the mid-longitudinal axis of the shaft". This would appear to positively require sufficient structural detail for the head 18, 118 to be formed at an acute angle relative to the longitudinal axis of the shaft. There appears to be no support in the disclosure for the head 18 to be made with an acute angle relative to the longitudinal axis of the shaft. The angle only occurs during use when the rivet is forced into the tissue. This claim language raises questions as to what is intended to be comprehended by the claims.

On page 7, sub-section (ii), appellant states that the examiner contends that claim 145 recites the noted angle is greater than 90 degrees when in actuality claim 145 recites the noted angle is less than 90 degrees. It is not clear how much weight can be given this argument when on page 5 of the examiner's answer regarding paragraph e) the examiner has quoted the claim word for word and includes the noted angle being recited as less than 90 degrees.

Appellant further disagrees with the examiner's contention that the angular relationship is a positive structural limitation by stating that the examiner is attempting to improperly read into the claim a temporal limitation that is not recited. This is exactly what is the problem with the claim. There is no temporal limitation of the recited language and therefore one would have to

assume that it is a positive limitation. There is no language stating that the angular relationship only occurs during use. Rather the claim recites the angular relationship as a fact.

Appellant in the first paragraph of page 10 of the Reply Brief states that the examiner fails to address claims 176-182, 186-210, 242-244 and 248-292 and therefore are allowable. Due to the excessive nature of appellant's obsession to use 300 claims to describe a simple rivet, not every claim can be pointed out. Knowing that the examiner has the same amount of time to examine a typical 20 claim application as a 300 claim application, appellant has overwhelmed the examiner in hopes of at least one claim will slip through. A review of the above claims will reveal whether or not these claims contain the language the examiner is referring to. Claim 177 recites that the flexible member forms an included angle that is obtuse relative to the mid-longitudinal axis of the shaft. Claim 178 recites the flexible member forms an acute angle relative to the mid-longitudinal axis of the shaft.

Regarding appellant's arguments under section L. on page 10 of the Reply Brief states that the head portion of Warren's device is incapable of flexing. The Warren rivet is made of the same material, formed in the same configuration and has a head thickness of 0.069 inches. The head of Warren would flex at least to a certain extent when it is inserted into the tissues. Even if the rivet of Warren is intended to withstand repeated blows so is appellant's device. Appellant's device is intended to be forced into tissue and is capable of withstanding repeated blows in order to push the rivet into the desired location. These arguments are speculation on what happens to the rivet when it is being inserted into the body. It is not clear how much weight can be given such arguments.

Appellant has also argued that a new grounds of rejection was made in the examiner's answer. Appellant's position is that a new rejection was made rejecting claim 144 under 35 U.S.C. 112 first paragraph as not being supported in the specification as originally filed. As can be found in the final rejection as well as the examiner's answer, claims 29-300 were rejected under 35 U.S.C. 112 first paragraph as not being adequately supported in the specification. Claims 29-300 include claim 144. Therefore this is not a new rejection. The examiner may have singled out this one claim in response to appellant's arguments to highlight the claim language that is not supported by the original disclosure. The issue whether or not the original disclosure supports the new claims drawn to the head or flexible member of the rivet "forming an included angle relative to the mid-longitudinal axis of said shaft that is greater than 90 degrees." This is one of the bases of the objection to new matter under 35 U.S.C. 132 paragraph g) in the examiner's answer.

Appellant also argues that a new rejection of claim 192 under 35 U.S.C. 103(a) over Warren in view of Duncan was made in the examiner's answer. As can be clearly seen in the examiner's answer page 9 beginning on line 14, claim 192 is rejected over the references as applied to the claims above and further in view of Duncan, Chisholm et al. or Paravano. Claims 187 and 176 on which claim 192 depends are rejected over Warren as set forth on page 7 beginning on line 3. Therefore the rejection of claim 192 over Warren in view of Duncan is not a new rejection.

Appellant also argues that the examiner's answer made a new rejection on the basis that the specification does not meet the enablement requirement under 35 U.S.C. 112 first paragraph. There is no enablement requirement rejection and therefore there is no new grounds of rejection.

As noted in appellant's reply brief "the Examiner's Answer, while addressing Appellant's remarks with respect to the Examiner's new matter objection under 35 U.S.C. 132, the Examiner stated that '[t]he specification doesn't appear to provide such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.'" The examiner's comment is regarding the 45 U.S.C. 132 objection not somehow creating a new rejection. The examiner was merely trying to make a point that the specification as originally filed does not appear to provide sufficient disclosure to enable any person skill in the art to know if one is to make the head/disc at an angle to the shaft or the angle is a result of the rivet being forced into tissue during use. There also doesn't appear to be sufficient disclosure to know how to design the instant invention over the prior art. What structural limitations does one have to put into the instant invention to distinguish over the prior art since the prior art is made of the same material and has the same configuration?

The only difference between the instant invention and the prior art is that the head is flexible when it is forced into the tissue during use. The prior art is made of the same material, has the same general configuration and has a head that is 0.069 inches thick. Appellant argues that it is not flexible but the instant invention is. A head that is only 0.069 inches thick would flex. It is not clear how one would distinguish the prior art from the claimed invention when the only difference is contingent on what happens to the device during use and there is no positive structural limitation to define over the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danton DeMille whose telephone number is (571) 272-4974.

The examiner can normally be reached on M-Th from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson, can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

28 November 2005

Danton DeMille
Primary Examiner
Art Unit 3764